

Provisional Election

In compliance with the requirements of 37 C.F.R. §1.143, applicants provisionally elect (with traverse) claims 1, 5, 14 and 24 – 41 directed to foams composed of a high-temperature-resistant thermoplastic selected from polyether sulfones.

Remarks

The Examiner has required election/restriction pursuant to 35 U.S.C. §121 to a single species of the Markush group of claim 1. Applicants' traverse this restriction requirement.

MPEP § 806.05(j) states that “[t]he burden is on the Examiner to provide an example to support the determination that the inventions are distinct” Instead of providing an example to support the determination that the inventions are distinct, the Examiner makes two cursory allegations. First, the Examiner comments that “amended claim 1 ... is NOT of the same scope as the original claim 4 as some of the originally listed species of the thermoplastic are DELETED from the scope of now amended claim 1[,]”¹ and alleges that the species of the Markush group of claim 1 are “independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species.”² This conclusion is in clear error, because none of the dependent claims 5, 14, or 24 – 41 are directed to a single species of the Markush group of claim 1. To the contrary, the dependent claims further specify features of independent claim 1, for example, glass transition temperature, open-cell factor, cell size, density, or the temperature above which the plastic is thermoplastically extrudable. Second, the Examiner alleges that “these species are not obvious variants of each other based on the current record.”³ Again, there are no claims to different species reciting mutually exclusive characteristics of the species. Moreover, all of the species mentioned in the Markush group in claim 1 are required to be in the form of foams having an open-cell structure, wherein the open-cell factor for the foam is at least 75%, and wherein the foam

¹ Page 2, lines 1 – 4 of the present Office action (emphasis in original).

² Page 2, lines 10 – 12 of the present Office action.

³ Page 2, lines 12 – 13 of the present Office action.

has a cell size of from 50 to 2000 μm .

Most importantly, however, it must be recognized that the Examiner has merely concluded, without explanation, that the species of the Markush group of claim 1:

1. “are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species[.]”⁴ and
2. “are not obvious variants of each other based on the current record.”⁵

These cursory allegations are inadequate to support the present restriction requirement.

“The particular reasons relied on by the Examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.”⁶ Thus, the restriction requirement must be withdrawn, or a workable example provided. Applicants submit that, in light of the remarks made above, no sound basis to support the present restriction requirement could be put forward by the Examiner.

Moreover, according to MPEP §808, “[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction there between as set forth in the following sections.” The Examiner has not adequately set forth reasons why there would be a serious burden on the examiner if restriction is not required. For this reason, the present restriction requirement is in error and should be withdrawn.

In Conclusion:

The present requirement for restriction is in error, because the Examiner has not provided the “particular reasons relied on by the Examiner”⁷ and has not provided an

⁴ Page 2, lines 10 – 12 of the present Office action. PLEASE NOTE: the Examiner has not even specified whether the allegation is that the species are independent or whether the allegation is that the species are distinct. The Examiner merely states that the species are “independent or distinct.”

⁵ Page 2, lines 12 – 13 of the present Office action.

⁶ MPEP §808.01.

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example “to support the determination that the inventions are distinct....”⁸ In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner is welcome to contact the undersigned by phone to further the discussion.

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⁸ MPEP § 806.05(j)